

Application No.: 10/516,823



Docket No.: OMY-0041

IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Akira Kawahara et al.

Application No.: 10/516,823

Confirmation No.: 7306

Filed: June 1, 2005

Art Unit: 1641

For: DETECTION KIT, MEASUREMENT PLATE
THEREFOR, DETECTION METHOD,
EVALUATION METHOD, POLYCLONAL
ANTIBODY TO FROG VITELLOGENIN AND
MANUFACTURING METHOD THEREOF

Examiner: Christine E. Foster

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Restriction Requirement dated April 20, 2006, Applicant hereby provisionally elects with traverse Group V, claim 20, for continued examination.

Please note that Applicant reserves the right to file divisional applications covering the subject matter of the non-elected claims. Applicant also reserves the right to rejoin any applicable non-elected claims.

The Examiner has required a restriction under 35 U.S.C. §§ 121 and 372, and has alleged that the application contains inventions which are not linked so as to form a single general inventive concept under PCT Rule 13.1. Applicant respectfully disagrees, and therefore has traversed this restriction requirement. Applicant requests that the Examiner reconsider this restriction requirement in view of the following remarks.

This application is a National Phase of a PCT application under 35 U.S.C. § 371, and is not an application filed under 35 USC § 111(a). MPEP § 1893(d) points out that with respect to national stage applications filed under 35 USC § 371, restriction practice under 35 USC § 121 is inapplicable. Rather, Unity of Invention practice under PCT Rule 13 and 37 CFR § 1.475 applies. Accordingly, Restriction Requirements are governed under the Unity of Invention

standards, and the Examiner must clearly specify why the claims directed to different groups of inventions lack a common special technical feature. Namely, Unity of Invention exists when claims are directed to a common special technical feature. This is discussed in detail in Chapter 1800 of the MPEP. Examples concerning Unity of Invention are given in the Annex to the MPEP, specifically Part 2 of Annex B to the Administrative Instructions under the PCT.

The Examiner opines on pages 2-4 of the Office Action that the inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. However, based on Applicant's review of the claims, the Examiner has not correctly applied the standard for Unity of Invention as discussed in the MPEP.

The Examiner allegedly identifies seven Groups. However, the Examiner, in his identification of the Groups, makes numerous errors that further show that the restriction is improper. For example, the Examiner specifically states that Groups I-VII are drawn to a different invention even though each of the Groups share the same special technical feature of "*an antibody recognizing vitellogenin*". Thus, the same special technical feature for Groups I-VII establishes the Unity of Invention for the claims of Groups I-VII. As a result, all of the claims of Groups I-VII should be examined together under PCT Rule 13.

Accordingly, withdrawal of the Restriction Requirement based on lack of Unity of Invention is respectfully requested.

Applicants also traverse the Restriction Requirement since the examination of the claims of Groups I-VII poses no undue burden on the Examiner. Under §803 of the Manual of Patent Examining Procedure, if the search and examination of an entire application can be made without serious burden, the Examiner **must examine it on the merits, even though it includes claims to independent or distinct inventions**. For the reasons noted above, Applicant submit that the subject matter of the claims of Groups I-VII is sufficiently related that a thorough search for the subject matter of claim 20 of Group V would encompass a search for the subject matter of the remaining claims of Groups I-IV, VI and VII. This is evidenced by the International Search Report which, in fact, searched the claims of all the Groups (i.e. Groups I-VII). Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden (see MPEP §803 in which it is stated that "*if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions*")

It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. OMY-0041 from which the undersigned is authorized to draw.

Dated: May 22, 2006

Respectfully submitted,

By 
Lee Cheng

Registration No.: 40,949
RADER, FISHMAN & GRAUER PLLC
1233 20th Street, N.W.
Suite 501
Washington, DC 20036
(202) 955-3750
Attorney for Applicant